

REMARKS

Claims 1 – 3 are pending and under consideration in the above-identified application, and Claims 4 – 6 were withdrawn from consideration in response to a previous election requirement.

In the Office Action, Claims 1 – 3 were rejected.

In this Amendment, Claims 1 and 2 are amended. No new matter has been introduced as a result of this amendment.

Accordingly, Claims 1 – 3 are at issue.

I. 35 U.S.C. § 102 Anticipation Rejection of Claims

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by Uzoh et al. (“Uzoh”) (U.S. Patent No. 5,807,165). Although Applicants respectfully traverse this rejection, Claim 1 has been amended to clarify the invention and remove any ambiguities that may have been at the basis of this rejection..

Claim 1 is directed to an electropolishing apparatus. The electropolishing apparatus comprises a polishing surface plate including a cathode and turnably disposed, a polishing pad disposed on the polishing surface plate, to be impregnated with an electropolishing liquid, and showing electric conduction from the face side to the back side thereof in the state of being impregnated with the electropolishing liquid, a substrate holding unit for holding a work substrate with a work surface of the work substrate opposed to a polishing surface of the polishing pad, the substrate holding unit turnably disposed at a position opposed to the polishing pad, *an outer circumferential portion of the work surface disposed outside of the polishing surface of the polishing pad*, an anode to be brought into contact with the work surface of the work substrate held by the substrate holding unit, a chemical liquid supply unit for supplying a chemical liquid used for polishing onto the polishing pad, and a power source for supplying electric power between the cathode and the anode.

As amended, Claim 1 recites that an outer circumferential portion of the work surface disposed outside of the polishing surface of the polishing pad.

Referring to Applicants' Figure 1 as an illustrative example, Applicants' claimed invention comprises a polishing pad 16 disposed on the polishing surface plate 11, a substrate holding unit 21 for holding a work substrate 51 with a work surface 51S opposed to a polishing surface 16S of the polishing pad 16, and an outer circumferential portion of the work surface 51S disposed outside of the polishing surface 16S of the polishing pad 16.

This is clearly unlike Uzoh, which fails to disclose or suggest an outer circumferential portion of the work surface 51S disposed outside of the polishing surface 16S of the polishing pad 16. In fact, Uzoh teaches and illustrates in at least Figs. 1, 2, 7, 11, and 13, that the entire work surface 18 is disposed on the polishing surface of the polishing pad 64.

For at least this reason, Uzoh fails to teach or suggest all of the limitations of Claim 1.

Accordingly, Claim 1 is patentable over Uzoh, and Applicants respectfully request that this claim rejection be withdrawn.

II. 35 U.S.C. § 103 Obviousness Rejection of Claim 2

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Uzoh et al. in view of Duboust et al. ("Duboust") (U.S. Publication No. 2003-0116446) further in view of Chang et al. ("Chang et al.") (U.S. Patent No. 6,206,760), and further in view of Kondo et al. ("Kondo") (U.S. Publication No. 2002-0061722). Applicants respectfully traverse this rejection.

Claim 2 is dependent on Claim 1, shown above to be patentable over Uzoh.

In addition to Uzoh, Duboust, Chang and Kondo also fail to teach or suggest an outer circumferential portion of the work surface disposed outside of the polishing surface of the polishing pad. As such, these references may not be properly combined to reject Claim 1. Thus, Claim 2 is patentable over the cited references, taken singly or in combination with each other.

Accordingly, Applicants respectfully request that this claim rejection be withdrawn.

III. 35 U.S.C. § 103 Obviousness Rejection of Claim 3

Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Uzoh in view of Duboust. Applicants respectfully traverse this rejection.

Claim 3 is dependent on Claim 1, shown above to be patentable over Uzoh.

As stated above, Duboust also fails to teach or suggest an outer circumferential portion of the work surface disposed outside of the polishing surface of the polishing pad. As such, these two references may not be properly combined to reject Claim 1. Thus, Claim 3 is patentable over the cited references, taken singly or in combination with each other.

Accordingly, Applicants respectfully request that this claim rejection be withdrawn.

IV. Conclusion

In view of the above amendments and remarks, Applicant submits that Claims 1 – 3 are clearly allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Respectfully submitted,

Dated: 3/16/07

By: Christopher P. Rauch
Christopher P. Rauch
Registration No. 45,034
SONNENSCHN NATH & ROSENTHAL LLP
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, Illinois 60606-1080
(312) 876-8000